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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/683,292	12/10/2001	Laurence E. Holt	1044.012US1	8482

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EXAMINER	
CHAMPAGNE, DONALD	
ART UNIT	**PAPER NUMBER**
3622	

DATE MAILED: 05/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/683,292	HOLT	
	Examiner	Art Unit	
	Donald L. Champagne	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *17 December 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *11-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *11-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *10 December 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *12-17-04*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed on 17 December 2004 have been fully considered but they are moot in view of the new grounds of rejection. The following rejection addresses the claim amendment filed on 11 July 2004.

Information Disclosure Statement

2. The two PTO-1449 forms filed on 17 December 2004 are objected to because the typed text is too small to be legible. See 37 CFR 1.52(a) and (b).

3. These forms will be accepted without payment of additional fees if resubmitted within 2 months from the date of mailing of this Office action, with the added information printed in a font no smaller than 9 point (height of 0.32 cm or 0.13 inch).

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 11-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The limitation at the end of each claim 11 and 16, "... without the user having to perform any action" is new matter. "Any negative limitation or exclusionary proviso must have a basis in the original disclosure. ... The mere absence of a positive recitation is not basis for an exclusion." (MPEP § 2173.05(i))

Claim Rejections - 35 USC § 102 and 35 USC § 103

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claims 11 and 13-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Goldhaber et al. (US005855008A).

9. Goldhaber et al. teaches (independent claim 11) a method comprising: registering by a user/*consumer* with an information provider over a *computer network* ***102*** (col. 12 lines 40-42 and Fig. 1), where personal information of the consumer (*database* ***120***) is stored centrally (col. 12 lines 19-21 and col. 8 lines 28-30) by the information provider, the user/*consumer* being a live person; storing a user identifier (*contact information* ***122***, col. 12 lines 24-28) at the user (e.g., the user's *password*, col. 16 line 62); requesting a desired subset of the personal information of the user by an organization to the information provider (col. 7 lines 1-3) based on the user identifier as retrieved from the user (col. 17 line 4); upon confirming that the organization/*advertiser's account* is valid (col. 11 lines 43-44), which reads on verifying that the organization is a subscribing organization, providing the organization with the desired personal information (*providing requested information*, col. 11 lines 37-38), transferring funds from the account of the organization/*advertiser's account* to the *consumer's account* (col. 11 lines 43-44), which reads on paying by the organization for access to the desired personal information and paying the user a portion of the amount collected from the organization for access to the desired personal information; repeating the process for a desired second subset of the personal information by a second organization/*advertiser*, wherein the user is paid for access to the desired second subset of the personal information without the user having to provide any action (beyond registering and providing said in formation to *consumer database* ***120***.

10. Goldhaber et al. also teaches at the citations given above claims 13-15.

11. Claims 12 is rejected under 35 U.S.C. 103(a) as being obvious over Goldhaber et al. Goldhaber does not teach sending the user identifier to the user prior to storing said identifier at the user. Because it is good practice to confirm that the proposed identifer is indeed unique, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add the teachings of Goldhaber et al. that the user identifier be sent to the user, confirming its uniqueness, prior to storing said identifier at the user.

12. Claims 16-20 are rejected under 35 U.S.C. 103(a) as being obvious over Goldhaber et al. in view of Thomlinson et al. (US006044155A).

13. Goldhaber does not teach (independent claim 16) encrypting the personal information of a user by the information provider, storing said encrypted information locally at the user, and providing a subscribing organization with a decryption key for access to said personal information. Thomlinson et al. teaches encrypting the personal information of a user by the information provider (the *network supervisor computer*, col. 2 lines 19-21 and col. 3 lines 7-12), storing said encrypted information locally at the user (col. 2 lines 15-17), and providing a subscribing organization with a decryption key for access to said personal information (inherently, because Thomlinson et al. teaches that enciphering is done to preventing unauthorized access, col. 1 lines 21-23, so providing a decryption key is tantamount to authorizing access). Because Thomlinson et al. teaches that local storage adds security (col. 1 lines 62-64), it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add the teachings of Thomlinson et al. to those of Goldhaber et al.

14. Goldhaber et al. also teaches at the citations given above claims 17, 19 and 20.

15. Goldhaber does not teach (claim 18) that the information provider does the decryption. Because it further guard the encryption from being compromised, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add to the teachings of Thomlinson et al. and Goldhaber et al. that the decryption be done by the information provider.

Conclusion

16. Applicant's amendment filed 11 July 2005 necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

17. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 571-272-6717. The examiner can normally be reached from 6:30 AM to 5 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at donald.champagne@uspto.gov, and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717.

19. The examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

20. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

21. **AFTER FINAL PRACTICE** – Consistent with MPEP § 706.07(f) and 713.09, prosecution generally ends with the final rejection. Examiner will grant an interview after final only when applicant presents compelling evidence that "disposal or clarification for appeal may be

accomplished with only nominal further consideration" (MPEP § 713.09). The burden is on applicant to demonstrate this requirement, preferably in no more than 25 words. Amendments are entered after final only when the amendments will clearly simplify issues, or put the case into condition for allowance, clearly and without additional search or more than nominal consideration.

22. Applicant may have after final arguments considered and amendments entered by filing an RCE.

23. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, www.uspto.gov. At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.

Donald L. Champagne
Primary Examiner
Art Unit 3622

28 April 2005

DONALD L. CHAMPAGNE
PRIMARY EXAMINER